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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,055	02/07/2001	Yuichi Asami	Q62904	7352

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EXAMINER	
CAPRON, AARON J	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/778,055	ASAMI ET AL.	
	Examiner	Art Unit	
	Aaron J. Capron	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 25 March 2004.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-35 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is a response to the Amendment received on March 25, 2004, in which claims 1, 7-8, 11, 13-22 and 25-32 were amended. Claims 1-35 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2004 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada Sone (U.S. Patent No. 5,919,047) in view of Tsai et al. (U.S. Patent No. 6,352,432; hereafter "Tsai").

Sone discloses a karaoke machine that includes first original music output means for outputting during automated karaoke play at least a main part of first original music containing the main part (Figure 7B, first music piece section) and a post-amble subsequent thereto (Figure 7B, end of the first music piece section that fades out, 9:23-52); a second original music output means for outputting during automated karaoke play at least a main part of second original music containing a preamble (Figure 7B, portion that fades in at the beginning of the second music piece section) the main part subsequent thereto (Figure 7B, second music piece section); connection music output means for outputting during automated karaoke play predetermined connection music (Figure 7B,); timing control means for controlling during automated karaoke play the second music output means and the connection music output means such that main part end timing of the original music coincides with start timing of the connection music, and the main part start timing of the second original music coincides with output with output end timing of the connection music (10:7-42), but does not disclose that the karaoke device is a type of game. However, Tsai discloses a karaoke machine that is a game device that sets up a competition between two opposing karaoke singers (apparatus) in order to determine who the crowd thinks is the superior karaoke singer. One would be motivated to combine the references in order to provide a match between two singers and to determine who the better singer is. Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to incorporate the karaoke game play of Tsai into the karaoke machine of Sone in order to provide a match between two singers and to determine who the better singer is.

Referring to claims 2 and 3, Sone in view of Tsai disclose the ability to adjust the volume (Sone 10:7-42).

Referring to claims 4-6 and 33-35, Sone discloses that in order to ensure a smooth transition from a first piece of music to a second piece of music, the device uses cross-fading for the volume and the tempo (Figure 7B; 9:23-52).

Referring to claims 7-9, Sone in view of Tsai disclose a game machine that has the ability to store audio data (Sone 3:39-51). Sone in view of Tsai disclose using a

Referring to claim 10, Sone in view of Tsai disclose a game machine that has original music storage means, original music end timing storage means, connection music storage means (Sone 10:7-42, 11:61-63), original music reproduction means, main part end timing monitoring means, connection music output means and volume control means (Sone 10:7-42).

Referring to claims 11 and 12, Sone in view of Tsai disclose a game machine that has original music storage means, main part start timing storing means, connection music storage means, original music reproduction start timing storage means, connection music output means, original music reproduction start timing monitoring means, original music reproduction means, main part start timing monitoring means and volume control means, the volume not adjusting as the music is reproduced.

Claims 13-15 correspond in scope to a method set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 16-18 correspond in scope to an information storage medium set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 19-20 correspond in scope to a distribution device set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claim 21 corresponds in scope to a game machine set forth for use of the game machine listed in the claims above and is encompassed by use as set forth in the rejection above.

Referring to claim 22, Sone in view of Tsai disclose a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions (Tsai discloses either one or multiple of players can compete in the game), storage means for storing the play conditions and game advancing means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game.

Referring to claim 23, Sone in view of Tsai disclose the game advancing means further comprises timing guidance image display means for displaying timing guidance image in conformity with the play condition stored in the play condition storage means, for guiding timing at which the player is to operate the controller in accordance with the game music (Tsai discloses two players fighting based upon frequency, volume, rhythm and the total points 4:56-5:2).

Referring to claim 24, Sone in view of Tsai disclose a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions, storage means for storing the play conditions and game advancing

means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game, the ability to change and control the music in real time based upon player's preferences by adjusting the music editor, but does not disclose that the original music determination means determines the original music to output based on a random number. However, it is notoriously well known in the art to use random music in order to update the game so the sound does not create redundancy in the game. The random generation of sound could ensure that the game would create interest in the game for a longer period of time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the random generation of the music to Araki's invention in order to create a game that is non-repetitive in nature and therefore, could keep player's attention for a longer time period.

Claims 25-29 correspond in scope to a game machine set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 30-32 correspond in scope to a computer readable storage medium set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Response to Arguments

Applicant's arguments filed March 25, 2004 have been fully considered but they are not persuasive.

Applicant argues that the connection music clearly refers to music that joins two main pieces and that the connection music is substantially shorter than the first and/or second main pieces. However, Sone in view Tsai discloses using songs and songs that can vary in length in a manner that the duration of one song is substantially shorter than the song prior to it. For example, Stairway to Heaven by Led Zeppelin which plays for 8:03 minutes followed by Her Majesty by The Beatles which plays for 23 seconds. While this may be an extreme example, there are plenty of 4-minute songs that could be followed by a 2-minute song and so forth, which could be classified as being substantially different in duration, see MPEP 2173.05(b) for the term "substantially." Further, the Applicant defines the connection music as clearly referring to music that joins two pieces (see remarks, bottom of page 15 at. However, Applicant's specification and claim language do not clearly define or support that the connection music as being only music that joins two main pieces in a manner that would "fill the silence gap" between two main pieces. Accordingly, based upon the supplied definition of connection music, Applicant must consider whether claims such as claim 17 are enabled since the medium is storing only the second original music and the connection music and does not claim a first original music for the connection music to "join the two main pieces", wherein the first original music is essential for the invention as a whole. Therefore, the claimed invention fails to preclude the invention of Sone in view of Tsai.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art

of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

JESSICA HARRISON
PRIMARY EXAMINER